

REMARKS

Applicant appreciates the Examiner's thorough consideration provided to the present application. Claims 1, 3-7 and 9-19 are currently pending in the instant application. Claims 1, 3-7 and 10 have been amended. Claims 2 and 8 have been cancelled without prejudice or disclaimer to the subject matter contained therein. Claims 16-19 have been added to rewrite multiple dependent claims 5 and 6 as separate dependent claims. Claims 1 and 7 are independent. Reconsideration of the present application is earnestly solicited.

Priority

Applicant appreciates the Examiner's indication of acceptance of the certified copies of the corresponding priority documents for the present application.

Drawings

Applicant respectfully requests the Examiner's indication of acceptance of the formal drawings filed on January 11, 2001.

Information Disclosure Statement

Applicant appreciates the Examiner's acknowledgment of the Information Disclosure Statement filed on March 30, 2001. However, Applicant submits that the Examiner has not provided Applicant with an initialed copy of the Information Disclosure Statement filed on January 11, 2001. An additional copy of the Information Disclosure Statement (January 11, 2001) is provided as an attachment to this Amendment. The Examiner is respectfully requested to contact the undersigned via telephone if the Examiner requires an additional copy of the reference described in the Information Disclosure Statement filed on January 11, 2001.

Claim Rejection Under 35 U.S.C. § 102

Claims 1-15 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Watkins et al. (U.S. Patent No. 5,778,164). This rejection is respectfully traversed.

In light of the foregoing amendments to the claims, Applicant respectfully submits that all of the rejections have been obviated and/or rendered moot. Without conceding the propriety of the Examiner's rejection, but merely to expedite the prosecution of the present application, Applicant has amended claims 1 and 7 to clarify the invention for the benefit of the Examiner.

Specifically, Applicant submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention. Accordingly, this rejection should be withdrawn.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: "wherein the character image information generation means describes the character image information in order information representing the content of a printing order of the image data." Accordingly, this rejection should be withdrawn.

With respect to claim 7, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: "wherein the character image information is described in order information representing the content of a printing order of the image data." Accordingly, this rejection should be withdrawn.

In Watkins et al., a system for producing customized images and imprinting these images onto a variety of different formats is described (see col. 5, lines 40-43). The Examiner has alleged that Watkins et al. teaches or suggests a system that the character image information is described in order information representing the content of a printing order of the image data. However, Applicant submits that this feature has not been identified in the

Watkins et al. patent by the Examiner, e.g., by the Examiner with positive recitation of the location of these features in Watkins et al. or identification by Applicant. Applicant's review of this reference indicates that the alleged character image information of Watkins et al. appears to be the "additional graphics/images and/or text to predetermined locations" described by Watkins et al. at col. 8, lines 55-68 through col. 9, lines 1-33. However, Applicant submits that even if this information were considered analogous to the character image information of the claimed invention, Watkins et al. does not teach or suggest a system where the character image information is described *in order information representing the content of a printing order of the image data.* (Emphasis added)

In the present invention, the order information refers to "information such as a processing number indicating the content of a service (such as generation of an additional print or a postcard), an image number specifying a photograph, a print size, the quantity of prints, a quality of printing paper (such as glossy or non-glossy), the thickness of the paper, the content of photographic processing, and trimming specification, for example." (see page 6, line 24-page 7, line 5 of the present application and FIGs. 3-5 for exemplary embodiments)

In Watkins et al., the alleged character image information is described in further detail at col. 8, lines 55-68 through col. 9, lines 1-20:

The CPU 10 may also provide the user with the ability to add additional graphics/images and/or text to predetermined locations on the prestored image as illustrated by step 110. As illustrated by FIG. 3, a prestored image 70 is shown prior to it being combined with the customer-generated image. As can be seen, the *prestored image 70 has five (5) locations, indicated by numerals 51,52,53,54,55 wherein customer-generated images, portions of customer-generated images or other stored images can be place.* Any desired number of locations may be provide and may vary in accordance with the selection of the prestored image.

In addition, in the selected prestored image, there are additional locations, indicated by numerals 61,63,65,67 where additional personalized information such as a name, place or date may be placed. As can be seen from the prestored image as illustrated in FIG. 3, the theme is that of a vacation. However any other desired theme may be employed, for example, any sports activity, any location or artistic theme.

Referring to FIG. 4, there is illustrated a merged image formed by the combining of the consumer-generated images and text with the prestored image of FIG. 3 that has been imprinted on a desired format. At location 54 only a portion of a consumer-generated image is required. In this particular instance, the head of a person. In the particular embodiment illustrated the output format is a photographic picture. However, this same merged image may be placed on any desired format. As represented by box 112, the merged image may be viewed on the monitor whereby the customer and/or operator will inspect and approve the merged image. *If no further adjustments are desired or required, the merged image is sent to the appropriate output format as illustrated by box 114.*

It is, of course, to be understood that the merged image may be produced in more than one format as desired by the consumer. As seen in FIG. 4, personalized information has been provided at locations 61-67. *The providing of discrete location wherein the user's generated image may be simply placed allows for quick and*

easy combining of images while at the same time providing a high quality professional looking end product. (Emphasis Added)

Applicant submits that the user's generated image that is to be merged onto the final image is not described or sent via order information representing the content of a printing order of the image data. Instead, the user's generated image appears to be prestored information that is merged into a final image in prestored or prearranged locations that are not designated in order information representing the content of a printing order of the image data. Accordingly, this rejection should be withdrawn.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submit that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicant respectfully submit that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

CONCLUSION

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of- the-art, no further comments are deemed necessary with respect thereto.


All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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